

REMARKS:

Claims 1-22 are currently pending in the Application.

Claims 1-22 stand rejected under 35 § U.S.C. 103(a) over Cain et al. (WO 2001/55886 A2, hereinafter referred to as "*Cain*"), in view of Wong et al. (USP 5,890,175, hereinafter referred to as "*Wong*").

The Applicant respectfully submits that all of the Applicant's arguments are without *prejudice* or *disclaimer*. In addition, the Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicant further respectfully submits that by not responding to additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicant are considered sufficient to overcome the Examiner's rejections.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-22 stand rejected under 35 § U.S.C. 103(a) over *Cain* in view of *Wong*.

The Applicant respectfully submits that *Cain* or *Wong*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 1-22. Thus, the Applicant respectfully traverses the Examiners obvious rejection of Claims 1-22 under 35 U.S.C. § 103(a) over the proposed combination of *Cain* or *Wong*, either individually or in combination.

The Proposed *Cain-Wong* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to independent Claim 1, this claim recites:

An ***electronic commerce system for generating, updating, and managing multi-taxonomy environments***, the system comprising:

one or more sellers' databases operable to store product data for one or more products;

a master global content directory including a plurality of product classes organized in a hierarchy according to a first classification system, each product class categorizing a plurality of products and associated with one or more attributes of the products categorized in the product class, ***at least one of the product classes having one or more associated product pointers that identify one or more of the sellers' databases;***

one or more secondary content directories including one or more product classes organized in a hierarchy according to a second classification system that is distinct from the first classification system of the master global content directory, each product class being mapped to one or more product classes in the master global content directory and having one or more associated class pointers that identify the one or more product classes in the master global content directory to which the product class is mapped; and

a search interface operable to:

receive a selection of a product class of a secondary content directory from a user, the selected product class having at least one class pointer identifying at least one product class in the master global content directory; and

communicate, in response to selection of the product class by the user, a search query to one or more of the sellers' databases to search product data stored in the sellers' databases identified by one or more of the product pointers to facilitate a commercial transaction involving one or more products. (Emphasis Added).

In addition, *Cain* or *Wong*, either individually or in combination, fail to disclose each and every limitation of independent Claims 8, 15, and 22.

The Applicant respectfully submits that *Cain* fails to disclose, teach, or suggest independent Claim 1 limitations regarding an “***electronic commerce system for generating, updating, and managing multi-taxonomy environments***” and in particular *Cain* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a “master global content directory including a plurality of product classes organized in a hierarchy according to a first classification system, each product class categorizing a plurality of products and associated with one or more attributes of the products categorized in the product class, ***at least one of the product classes having one or more associated product pointers that identify one or more of the sellers' databases***”.

However *Cain* merely discloses that the “itemdata” table may comprise more than one database. The “itemdata” table disclosed in *Cain* is merely an aggregated database of product information. For example, *Cain* discloses a hierarchical product classification system which implements a spider module for searching a network (typically internet websites) for textual information pertaining to products (Figure 4B, page 4, lines 7-12, page 25, lines 12-27), aggregating the product information in a table of a database (page 24, lines 3-5), classifying the aggregated products according to a system taxonomy (page 24, lines 6-29), and optionally generating statistical profiles for association with the products using the information accumulated for the products (page 24, line 30 to page 25, line 8). Ultimately, the database is made available to users on a network such that users can search for products (or otherwise analyze the aggregated product information) and the associated product information and statistical profiles using a variety of search interfaces (page 63, line 13 to page 64, line 5).

Accordingly, *Cain* merely teaches that the aggregated item data maybe stored in more than one database. However, the databases disclosed in *Cain*, that comprises the item data are merely part of the system of *Cain* (i.e., the databases are not seller databases). Thus, *Cain* fails to teach, suggest, or even hint at a “master global content directory including a plurality of product classes organized in a hierarchy according to a first classification system, each product class categorizing a plurality of products and associated with one or more attributes of the products categorized in the product class, **at least one of the product classes having one or more associated product pointers that identify one or more of the sellers’ databases**” as recited in independent Claim 1. The Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Cain* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Cain*.

The Office Action Acknowledges that *Cain* Fails to Disclose Various Limitations Recited in Applicant's Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Cain* fails to disclose various limitations recited in independent Claim 1. Specifically the Examiner acknowledges that *Cain* fails to teach “different classification systems”. (18 May 2007 Office Action, Page 2). However, the Examiner asserts that the cited portions of *Wong* disclose the acknowledged shortcomings in *Cain*. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Wong*.

In addition, the Examiner asserts that “it would be inherent from the prior art that the higher-level group (master in relation to the lower level group can be classified based on a different classification system (classification category) than from secondary group or items in the taxonomy structure”. ***The Applicant*** respectfully disagrees and ***respectfully traverses the Examiner's assertions regarding the purported inherent features in Cain or Wong.***

The Applicant respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight to reach this conclusion and reconstructive hindsight is improper under 35 U.S.C. § 103. An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. (*In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency requires that the asserted proposition necessarily flow from the disclosure. (*In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986)). ***It is not enough that a reference could have, should have, or would have been used as the claimed invention.*** “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (*Oelrich*, at 326, quoting *Hansgirk v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28

U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789). “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (*Skinner*, at 1789, citing *Oelrich*). Where anticipation is found through inherency, the Office’s burden of establishing *prima facie* anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” (*Skinner* at 1789).

The Examiner’s *Official-Notice* is improper under MPEP § 2144.03

The Applicant respectfully submits that the Applicant is confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. The Applicant respectfully requests clarification as to the subject matter for which Official Notice is being taken. ***The Applicant respectfully traverses the Official Notice because the asserted facts***, as best understood by the Applicant, ***are not supported by substantial documentary evidence or any type of documentary evidence*** and appear to be the Examiner’s opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner’s conclusion. (See MPEP § 2144.03). ***The Applicant respectfully requests the Examiner to produce authority for the Examiners Official Notice.***

Only “in limited circumstances,” is it “appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection”. (MPEP § 2144.03). “Official notice unsupported by documentary evidence ***should only be taken by the examiner*** where the facts asserted to be well-known, or to be common knowledge in the art are ***capable of instant and unquestionable demonstration as being well-known.***

With respect to the subject Application, the Examiner's statement that the "an argument that says a database is not a seller's database does not hold muster since this is well known in the art" and "*Cain* itself points out Ebay throughout for making his points clearer and it is well known in the art that Ebay and other similar organizations provide sellers a way to make their own databases which includes different products that the seller is providing to buyers", ***is not capable of instant and unquestionable demonstration as being well-known***. (18 May 2007 Office Action, Page 2). (Emphasis Added). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '***capable of such instant and unquestionable demonstration as to defy the dispute***' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is ***never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record***, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection***). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in

the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

With respect to the subject Application, ***the Examiner has not properly Officially Noticed or not properly based the Official Notice on common knowledge.*** The Examiner's conclusory statement:

Furthermore, an argument that says a database is not a seller's database ***does not hold muster since this is well known in the art.*** In fact, *Cain* itself points out Ebay throughout for making his points clearer and ***it is well known in the art that Ebay and other similar organizations provide sellers a way to make their own databases*** which includes different products that the seller is providing to buyers. (18 May 2007 Office Action, Page 2). (Emphasis Added)

The above noticed Examiner's conclusory statement ***does not adequately address the issue that this statement is considered to be common knowledge or well-known in the art.*** The Applicant respectfully submits that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. The Applicant further respectfully submits that the Applicant has adequately traversed the Examiner's assertion of Official Notice and directs the Examiner's attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Claims 1-22 based on the Official Notice, the Applicant respectfully requests that the Examiner provide

documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Applicant further respectfully requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

In addition, the Applicant respectfully points the Examiner to the pertinent sections of the MPEP, directly on point to determine whether the next Office Action should be made Final. In particular, the Applicants respectfully direct the Examiner's attention to the pertinent text of the MPEP, which states:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. (MPEP § 2144.03(D)).

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Cain-Wong* Combination

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Cain* or *Wong*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to modify *Cain et al.* to include different classification systems such as that taught by *Wong et al.*". (18 May 2007 Office Action, Page 6). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Cain* or *Wong*, either

individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be “in order to have a computerized method for dynamically generating and displaying a catalog including a plurality of items, each item being classified by at least group information and product information.” (18 May 2007 Office Action, Page 6). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion. ***The Applicant respectfully requests the Examiner to point to the portions of Cain or Wong which contain the teaching, suggestion, or motivation to combine these references for the Examiner’s stated purported advantage.*** The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Cain or Wong to render obvious the Applicant claimed invention.*** The Examiner's unsupported conclusory statements that “it would have been obvious to modify *Cain et al.* to include different classification systems such as that taught by *Wong et al.*” and that “in order to have a computerized method for dynamically generating and displaying a catalog including a plurality of items, each item being classified by at least group information and product information”, ***does not adequately address the issue of motivation to combine.*** (18 May 2007 Office Action, Page 6). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Cain or Wong*** either individually or in combination.

The Applicant's Claims are Patentable over the Proposed *Cain-Wong* Combination

The Applicant respectfully submits that independent Claims 8, 15, and 22 are also considered patentably distinguishable over the proposed combination of *Cain* or *Wong*, for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent Claims 2-7, 9-14, and 16-21: Claims 2-7 depend from independent Claim 1; Claims 9-14 depend from independent Claim 8; and independent Claims 16-21 depend from Claim 15. As mentioned above, each of independent Claims 1, 8, 15, and 22 are considered patentably distinguishable over the proposed combination of *Cain* and *Wong*. Thus, dependent Claims 2-7, 9-14, and 16-21 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons discussed herein, the Applicant respectfully submits that Claims 1-22 are not rendered obvious by the proposed combination of *Cain* and *Wong*. The Applicant further respectfully submits that Claims 1-22 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-22 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-22 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180

U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

16 August 2007
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy., Ste. 101
Tempe AZ, 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184